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REMARKS

The above-referenced patent application has been reviewed in light of the Office Action referenced above. Reconsideration of the above-referenced patent application in view of the following remarks is respectfully requested.

Claims 1-42 are pending in the application. Claims 1, 2, 8, 15, 16, 29, 30, 39, and 40 have been amended. The amendment is fully supported by the original disclosure. No new matter has been introduced.

Assignee respectfully requests that the amendment be entered after final, as many of the claim amendments pertain to formatting and do not change the scope of the claims. Assignee asserts that no prosecution history estoppel should result from the above amendments where the amendments were made to clarify Assignee's claims and/or broaden scope of the amended claims.

Claim rejections - 35 USC §103

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's admitted prior art from the Background section of the present application (hereinafter the "Background").

Assignee respectfully submits that, the Background does not teach or suggest, among other things, the limitation of independent claim 1 reciting "*using a preset calibration parameter to perform compensation and calibration for the captured image*". The Examiner is kindly reminded that the Examiner's initial burden of factually supporting any *prima facie* conclusion of obviousness includes that:

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. MPEP § 2143.03.

The Examiner asserts that the Background discloses:

Regarding claim 1, Applicant admits an image scanning method for a scanner, comprising the steps of: ... c) using a preset calibration parameter to perform compensation and calibration for the captured image 132 ... (Figs 1A and 1B). (See page 3 of the Office Action.)

The Assignee cannot agree. Assignee notes that the Examiner has failed to address what meaning, if any, the Examiner has given to the term "*preset*". Accordingly, Assignee respectfully submits that the Examiner is not giving a "*preset calibration parameter*" as is recited in claim 1 the clear meaning as would be understood to one of ordinary skill in the art. Instead the Examiner appears to be reading the recited "*preset calibration parameter*" as merely a "calibration parameter", thus impermissibly disregarding the explicit claim term of "*preset*".

First, Assignee notes that independent claim 1 recites a "*preset calibration parameter*" while independent claim 8 has no such recitation. Accordingly, at the very least the doctrine of claim differentiation demands that "*preset*" term of claim 1 be given a meaning by the Examiner.

Second, the Specification does not support the Examiner's contention that the calibration parameter discussed in the Background would be understood by one of ordinary skill in the art to teach or suggest a "*preset calibration parameter*" as is recited in claim 1. For example, the Background notes that the process of Fig. 1B involves:

[T]he image scanning process of a scanner adapted a conventional technique includes ... performing a pre-scanning process and calculating the calibration parameters 132 ... [a]lthough the calibration process may enable the scanner to get a better scanning quality for every scanning operation, the calibration process takes a lot of time. (See paragraphs [0005-0006] of the Background.)

Conversely, without limiting the claims to any single embodiment or reading limitations from the specification into the claims, the specification notes that:

[T]he calibration parameters may be directly stored in the Read Only Memory (ROM) or systems file at the plant site before shipment. Therefore the scanner of this system does not have to perform calibration process for deriving the calibration parameters before

every scanning operation, and may directly perform image scanning on the scanning object through the control module or system file to fetch the calibration parameters. (See page 5, lines 24-29 of the Specification.)

Accordingly, the Specification itself contrasts a conventional technique including calculating the calibration parameters for every scanning operation with directly storing calibration parameters before shipment. Without reading limitations into the claims from the specification, Assignee respectfully submits that one interpretation of a "*preset calibration parameter*" consistent with the specification would be calibration parameters directly stored before shipment in contrast to the Background.

Third, the ordinary meaning of "*preset*" does not support the Examiner's contention that the calibration parameter discussed in the Background would be understood by one of ordinary skill in the art to teach or suggest a "*preset calibration parameter*" as is recited in claim 1. For example, "*preset*" may mean "to set (an automatic control, for example) beforehand". See *The American Heritage® Dictionary of the English Language, Fourth Edition*. Retrieved February 22, 2007, from Dictionary.com website: <http://dictionary.reference.com/browse/preset>. Accordingly, Assignee respectfully submits that the Examiner is not giving a "*preset calibration parameter*" as is recited in claim 1 the clear meaning as would be understood to one of ordinary skill in the art. Instead the Examiner appears to be reading the recited "*preset calibration parameter*" as merely a "calibration parameter", thus impermissibly disregarding the explicit claim term of "*preset*". In the absence of the Examiner pointing to such a disclosure in the Background, Assignee requests that the rejection be withdrawn as the Examiner failed to establish that the Background renders obvious all of the features of claim 1.

Claims 2-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over admitted prior art from the Background section of the present application (hereinafter the "Background") in view of Wieloch (US Pat. No. 5,764,023). These rejections are respectfully traversed.

Assignee respectfully submits that, the Examiner has not established that the proposed combination of admitted prior art in view of Wieloch teaches or suggests, among other things, *"storing a preset calibration parameter via a control module comprising a read only memory (ROM) and using the stored calibration parameter to perform compensation and calibration for the captured image"* as recited in dependent claim 2. Specifically, claim 2 provides additional details regarding the *"preset"* nature of the *"calibration parameter"*, as argued above with respect to claim 1, by further specifying *"storing ... via a ... a read only memory"*. The Examiner asserts that Wieloch discloses:

Wieloch discloses a control module having a read only memory (ROM) for storing a preset calibration parameter and using the stored calibration parameter to perform compensation calibration for the captured image (Col 7 Lines 52-66). (See page 5 of the Office Action.)

First, the proposed combination would not render claim 2 obvious even if Wieloch were to be combined with the Background. Specifically, as Wieloch relates to the field of motor controllers for driving alternating current motors, a combination with the Background would at best modify the operation of the driving means of the optical chassis 12 (see page 1, lines 25-27 of the Specification) and have no impact on the processing of a captured image. Such a modification of the driving means of the optical chassis 12 of the Background has no relevance to the recited operations of claim 2. Additionally, the Examiner's characterization of Wieloch is inaccurate since the patent to Wieloch nowhere mentions anything about a captured image. In fact, a text search of US Patent No. 5,764,023 as obtained from the USPTO website was performed, and the words "capture", "captured", and "image" were not found to exist in the patent. In the absence

of the Examiner pointing to such a disclosure in the proposed combination, Assignee requests that the rejection be withdrawn as the Examiner failed to establish that the proposed combination renders obvious all of the features of claim 2.

Furthermore, the Examiner has asserted that the proposed combination is proper, arguing that:

Admitted prior art & Wieloch are combinable because they are from applications, which require control options. (See page 5 of the Office Action.)

Assignee submits that this is simply too vague of a basis to establish any motivation to combine the alleged admitted prior art with the teachings of the patent to Wieloch in the way proposed by the Examiner. In response, the Examiner has argued that:

In response to applicant's argument that Wieloch '023 is nonanalogous ... Wieloch teaches of a calibration system, which can easily be modified, to become incorporated in any image scanning circuitry". (See page 2 of the Office Action.)

The Examiner is kindly reminded that:

The examiner must determine what is "analogous prior art" for the purpose of analyzing the obviousness of the subject matter at issue. "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." In re Oetiker, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). (See MPEP § 2141.01(a))

Here, the present invention relates to an image scanning system and method for a scanner, whereas the patent to Wieloch relates to the field of motor controllers for driving alternating current motors. The applicant respectfully traverses the assertion that one of ordinary skill in the art of image scanning systems would turn to the field of ac motors for motivation to arrive at the claimed invention, or specifically to the field of ac motors to arrive a method for scanning an image to determine how to store a calibration parameter "*to perform compensation and calibration for the captured image*" as recited, for example, in claim 2. In other words, it

appears that any calibration discussed in the patent to Wieloch has nothing to do with the calibration of an image captured by a scanner, and in any event, the Examiner did not establish that calibration of an ac motor as disclosed in Wieloch is the same and/or analogous to calibration of a captured image as recited in the present claims. Thus, contrary to the Examiner's assertion, the patent to Wieloch appears to be directed to subject matter, namely ac motors, which are nonanalogous to the subject matter of the claimed invention, namely image scanning systems. Therefore, since the patent to Wieloch appears to disclose subject matter that is nonanalogous to the present invention, one having skill in the art of image scanning systems would not be motivated to combine an image scanning system with the ac motor of Wieloch to arrive at a combination that performs compensation and calibration of a captured image. As a result, the patent to Wieloch cannot support a rejection under § 103, so the rejection to claim 2 should be withdrawn. Claims 3-7 are similarly not obvious, at least on the same or similar basis as claim 2. Additionally, claims 2-7 are similarly not obvious, at least on the same or similar basis as claim 1.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's invention (Applicant has assumed for this response that the Examiner intended to instead refer to the Background section of the present application and not the "invention") in view of Edgar et al. (US Pat. No. 5,406,070). These rejections are respectfully traversed.

Assignee respectfully submits the proposed combination of Edgar with the Background does not teach or suggest, among other things, the limitation of independent claim 8 reciting *"performing one or more subsequent scanings of one or more subsequent scanning objects"*

without performing a subsequent pre-scanning calibration". In the Office Action, the Examiner has asserted that:

Edgar discloses performing one or more subsequent scanning of one or more subsequent scanning objects without performing a subsequent pre-scanning calibration (Fig 4). (See page 4 of the Office Action.)

The Assignee cannot agree. Conversely, Edgar describes the operation of FIG. 4 at column 4, line 31 to column 5, line 55, reading in part:

In step 320, a first portion of the object is scanned. (See Edgar at column 5, line 4.)

In step 350 it is determined whether the light variation is greater than a maximum predetermined value. If not, then processing returns to step 320 to scan a second portion of the object ... This process is continued until the whole object is scanned. Of course, this step may be skipped if ambient light is being used to scan the object. (See Edgar at column 5, lines 45-53.)

Accordingly, FIG. 4 of Edgar only discusses subsequent scanning steps to scan a "first portion of the object" and a "second portion of an object" until the whole object is scanned. Conversely, claim 8 recites *"performing one or more subsequent scanings of one or more subsequent scanning objects without performing a subsequent pre-scanning calibration"*. Here, Edgar does not teach or suggest such operation between a first scanning object and a subsequent scanning object *"without performing a subsequent pre-scanning calibration"* as FIG. 4 is only directed to operations occurring during the scanning of a **single object**. In the absence of the Examiner pointing to such a disclosure in proposed combination, Assignee requests that the rejection be withdrawn as the Examiner failed to establish that proposed combination renders obvious all of the features of claim 8.

Claims 9-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's admitted prior art from the Background section of the present application (hereinafter the

"Background") in view of Edgar '070 and further in view of Wieloch '023. These rejections are respectfully traversed.

As discussed above with respect to claim 2, since the patent to Wieloch appears to disclose subject matter that is nonanalogous to the present invention, one having skill in the art of image scanning systems would not be motivated to combine an image scanning system with the ac motor of Wieloch to arrive at a combination that performs compensation and calibration of a capture image. As a result, the patent to Wieloch cannot support a rejection under § 103, so the rejection should be withdrawn. Additionally, claims 9-14 are similarly not obvious, at least on the same or similar basis as claim 8.

Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's admitted prior art from the Background section of the present application (hereinafter the "Background") in view of Spitz (US Pat. No. 5,939,697). These rejections are respectfully traversed.

Assignee respectfully submits that, the proposed combination of Spitz with the Background does not teach or suggest, among other things, the limitation of independent claim 15 reciting "*determining if a calibration parameter is stored and calculating a calibration parameter if no calibration parameter is stored*". In the Office Action, the Examiner has asserted that:

Spitz discloses expressly a) judging if a control module having a calibration parameter is required; b) providing a scanning object if the outcome of the step a) is positive; wherein the following steps are performed when the outcome of step a) is negative: a1) performing pre-scanning and calculating calibration parameter; and a2) storing the calibration parameter in the control module (Col 8 Lines 19-28). (See page 9 of the Office Action.)

The Assignee cannot agree. Conversely, Spitz describes:

A key feature of the present invention is to provide calibration parameter groups, comprised of a plurality of calibration parameter values. The calibration parameter groups may be retrieved as needed and applied to calibrate the computing and evaluation system 31, as well as one or more selected and operatively coupled scanner units 20a and/or scanning apparatus 20, to accurately scan and evaluate indicia. (See Spitz at column 5, lines 45-53.)

Accordingly, Spitz discusses retrieving one of a plurality of calibration parameter groups selected based on particular conditions. Conversely, claim 15 recites *"determining if a calibration parameter is stored and calculating a calibration parameter if no calibration parameter is stored"*. Here, there is no indication that Spitz teaches or suggests operation where *"no calibration parameter is stored"*.

Second, Assignee respectfully submits that, the proposed combination of Spitz with the Background does not teach or suggest, among other things, the limitation of independent claim 15 reciting *"completing image scanning for the object and repeating said image capturing and said compensation without further performing the determining"*. Here, even if the Examiner establishes that Spitz teaches or suggests *"determining if a calibration parameter is stored and calculating a calibration parameter if no calibration parameter is stored"*, the Examiner has not also established that Spitz additionally teaches or suggests *"repeating said image capturing and said compensation without further performing the determining"*, as claimed. In the absence of the Examiner pointing to such a disclosure in proposed combination, Assignee requests that the rejection be withdrawn as the Examiner failed to establish that proposed combination renders obvious all of the features of claim 15. Claim 16 is similarly not obvious, at least on the same or similar basis as claim 15.

Claims 17-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over admitted prior art from the Background section of the present application (hereinafter the "Background") and Spitz '697 in view of Wieloch '023. These rejections are respectfully traversed.

As discussed above with respect to claim 2, since the patent to Wieloch appears to disclose subject matter that is nonanalogous to the present invention, one having skill in the art of image scanning systems would not be motivated to combine an image scanning system with the ac motor of Wieloch to arrive at a combination that performs compensation and calibration of a capture image. As a result, the patent to Wieloch cannot support a rejection under § 103, so the rejection should be withdrawn. Additionally, claims 17-22 are similarly not obvious, at least on the same or similar basis as claim 15.

Claims 23-25 and 33-35 are novel and not obvious at least on the same or similar basis as claim 1. Likewise, claims 24-25 and 34-35 are novel and not obvious at least on the same or similar basis as claim 2.

Claims 26-28 and 36-38 are novel and not obvious at least on the same or similar basis as claim 8. Likewise, claims 27-28 and 37-38 are novel and not obvious at least on the same or similar basis as claim 9.

Claims 29-32 and 39-42 are novel and not obvious at least on the same or similar basis as claim 15. Likewise, claims 31-32 and 41-42 are novel and not obvious at least on the same or similar basis as claim 17.

It is noted that claimed subject matter may be patentably distinguished from the cited reference for additional reasons; however, the foregoing is believed to be sufficient. Likewise, it is noted that the Assignee's failure to comment directly upon any of the positions asserted by the Examiner in the office action does not indicate agreement or acquiescence with those asserted positions.

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Conclusion

In light of the foregoing, reconsideration and allowance of the claims is hereby earnestly requested.

Invitation for a Telephone Interview

The Examiner is invited to call the undersigned attorney, James J. Lynch, at (503) 439-6500 if there remains any issue with allowance.

Additional fees

Any fees or extensions of time believed to be due in connection with this amendment are enclosed herein; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account 50-3703.

Respectfully submitted,
Berkeley Law & Technology Group, LLC

Dated: March 26, 2007

/James J. Lynch Reg. No. 50,153/
James J. Lynch
Reg. No. 50,153

Customer Number: 00043831

Berkeley Law & Technology Group, LLP
1700 NW 167th Place, Suite 240
Beaverton, OR 97006
503.439.6500

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